

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ASAO HARASHIMA

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Appeal No. 94-3414  
Application 08/054,998<sup>1</sup>

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ON BRIEF

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Before WEIFFENBACH, OWENS and HANLON, Administrative Patent Judges.

WEIFFENBACH, Administrative Patent Judge.

**DECISION ON APPEAL**

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claim 5 which is the only claim remaining in the application. We reverse.

**Claimed Subject Matter**

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<sup>1</sup> Application for patent filed April 29, 1993.

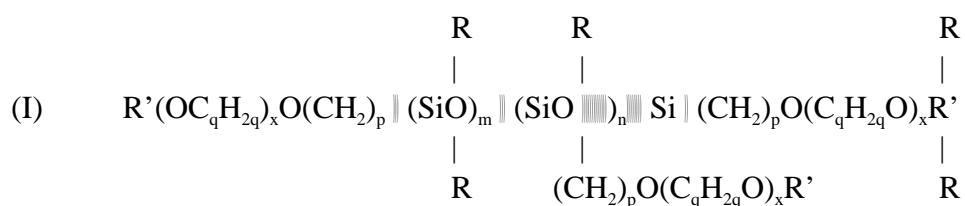
The claim on appeal is directed to a silicone gel composition and is intended for application to human skin. The composition comprises 20-95 percent by weight of a silicone oil, 2-30 percent by weight of a polyoxyalkylene organopolysiloxane, and 0.2-80 percent by weight water. A copy of claim 5 is appended to this opinion.

### Reference of Record

The following reference of record is relied upon by the examiner as evidence of obviousness:

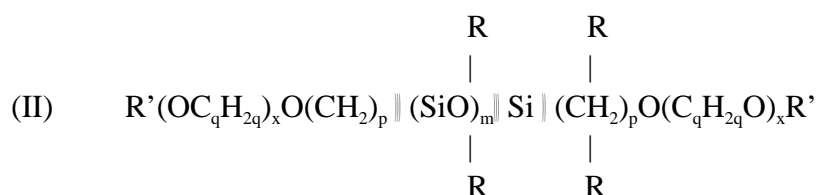
Ishiwata et al. (Ishiwata)<sup>2</sup>                      61-212324                      Sep. 20, 1986  
(Japanese Kôkai Publication)

Ishiwata discloses a silicone gel composition intended for application to human skin comprising 20-90 percent by weight silicone oil, 0.1-30 weight percent of one or more polyoxyalkylene-modified organopolysiloxanes, 0.1-15 percent by weight of an organically modified clay mineral, and 0.2-80 percent by weight water. The silicone oil can be dimethyl polysiloxane, methylphenylpolysiloxane, octamethylcyclotetrasiloxane, or decamethylcyclopentasiloxane. The polyoxyalkylene-modified organopolysiloxanes can be one of the following formulas:




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<sup>2</sup>Our consideration of this reference is based on an English language translation which is of record.



where R is a methyl group or, in some but not all positions, a phenyl group; R' is a hydrogen atom or an alkyl group with 1-12 carbon atoms; p is a number from 1 to 5; q is a number from 2 to 3; x, m, and n are averages, numeric values of polyoxyalkylene-modified organopolysiloxanes with a polyoxyalkylene content of 20-40 percent by weight, imparting to the polyoxyalkylene-modified organopolysiloxanes viscosities of 5-3000 centistrokes at 25E C.

### The Rejection

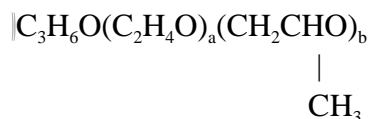
Claim 5 stands rejected under 35 U.S.C. § 103 as being unpatentable over Ishiwata.

### Opinion

We have carefully considered the respective positions advanced by appellant and the examiner. We will not sustain the examiner's rejection because the examiner has not made out a *prima facie* case of obviousness.

Appellant argues that the reference shows only a single oxyalkylene unit to be present in the molecule, and not two units "a" and "b" as required by claim 5. We have to agree with appellant. Appellant's organopolysiloxane as claimed requires a "b" unit having 5-50 units of an oxyisopropylene.

Thus if p=3 and q=2, then the difference between the oxyalkylenes in the claimed polysiloxane and that of the prior art is as follows:



Polyoxyalkylene Recited in Claims on Appeal



Prior Art

The examiner argues that the q values of Ishiwata can be a combination of 2 and 3. While the examiner acknowledges that Ishiwata does not disclose a polyoxyalkylene organopolysiloxane which contains a combination of 2 and 3, the examiner concludes “[a]bsent a clear showing of unexpected results for this combination of Q [sic, q] representing 2 and 3, the invention would be obvious” (answer: pp. 3-4; underscoring in the original). We do not share the examiner’s view.

Ishiwata does not teach or suggest a combination of 2 and 3 for q. On this record, the examiner has not presented any scientific reasoning based on the teaching of Ishiwata that would have led a person having ordinary skill in the art to add a “b” unit as required by appellant’s claim. For the foregoing reasons, the examiner’s rejection of claim 5 under 35 U.S.C. § 103 is reversed.

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We find ourselves in agreement with appellant that the primary examiner has failed to carry the burden of establishing a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1471-1472, 223 USPQ 785, 787-788 (Fed. Cir. 1984). Accordingly, the decision of the examiner is reversed.

**REVERSED**

CAMERON WEIFFENBACH	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
ADRIENE LEPIANE HANLON	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
TERRY J. OWENS	)	
Administrative Patent Judge	)	

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